

21



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,108	06/02/2000	Neil A Willcocks	2280.2620	6805

5514 7590 12/06/2004

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/587,108	Applicant(s) WILLCOCKS ET AL.	
	Examiner Thierry L Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on amendment filed on 8/27/04.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 31-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 8/27/04.
- Claims 1-30 have been canceled. Claims 31-70 are in pending. Claims 66-70 are newly added.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 31-33, 37-39, 43-44, 48-50, 54-56, 60-62, 66 are rejected under 35 U.S.C. 102(e) as being anticipated by Spurgeon et al (U.S. 2002/0008751).

Regarding claim 31, Spurgeon discloses a system (edible food product print system, fig. 1) for enabling a user to submit an image to be printed directly on a food product (printer 40 for printing edible inks on edible food items, fig. 1, par. 44), comprising:

- a first computer (image source 20 includes computer processing unit, fig. 1, par. 13, page 1) adapted to receive image data from the user (image source 20 receives image data from plurality of sources, i.e., scanner 22, disk drives 24, and etc, fig. 1) and communicate the image data over a network (network 10, fig. 1);
- a second computer (control unit 30, fig. 1, moreover, since network 10 is a LAN, WAN, and MAN network, plurality of computers can interconnected, pars. 13 and 19, pages 1-2) adapted to communicate with the first computer, the second computer being adapted to receive the transmitted image data over the network (control unit 30 receives image data transmitted from image source via network 10, fig. 1); and

Art Unit: 2624

- an ink-jet printer (inkjet printer 40, fig. 1) adapted to receive the image data from the second computer (images can be download and/or retrieve from plurality of sources via the network to control unit, pars. 13 and 19, pages 1-2) and print on the edible a high quality image that corresponds to the received image data.

Regarding claim 32, Spurgeon further discloses a system according to Claim 31, wherein the network is the Internet (Internet network, par. 19, page 2) and the first computer is a client computer operable to run Web browser software adapted to send and receive Hypertext Markup Language (HTML) forms over the World Wide Web (download images via Internet Web Site, par. 19, page 2).

Regarding claim 33, Spurgeon further discloses a system according to Claim 31, wherein the network is a local area network (LAN, WAN, MAN, par. 19, page 2).

Regarding claims 37-39: Claims 37-39 are the method claims corresponding to the apparatus claims 31-33 (respectively). The methods are inherent and included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claims 31-33 above.

Regarding claims 43-44, please see rejection rationale/basis as described in claims 31-33 above.

Regarding claims 48-50, please see rejection rationale/basis as described in claims 31-33 above.

Regarding claims 54-56: Claims 54-56 are the method claims corresponding to the apparatus claims 31-33 (respectively). The methods are inherent and included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claims 31-33 above.

Regarding claims 60-62: Claims 60-62 corresponds to claims 31-33 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (floppy

Art Unit: 2624

disk, Zip drives, par. 13, page 2) for storing computer programs, hence claims 60-62 would be rejected using the same rationale as in claims 31-33.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 34-36, 40-42, 45-47, 51-53, 57-59, and 63-65 rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon as described in claims 31, 37, 43, 48, 54, and/or 60 above, and in view of Young (U.S. 6058843).

Regarding claim 34, Spurgeon does not explicitly disclose wherein a print image having resolution greater than 200 dpi even if printed using a single printhead and a single pass printing.

Young, in the same field of endeavor for edible printer, discloses a print image having resolution greater than 200 dpi (360 dpi, col. 2, lines 30-36) even if printed using a single printhead and a single pass printing.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Spurgeon as per teachings of Young because of a following reason: (1) to provide high quality printed edible images (Spurgeon, par. 12, page 1).

Therefore, it would have been obvious to combine Spurgeon with Young to obtain the invention as specified in claim 34.

Regarding claim 35, Spurgeon further discloses ink-jet printer (par. 17, page 2) is a drop-on-demand ink-jet printer (par. 10, page 1).

Art Unit: 2624

Regarding claim 36, Young further discloses wherein the printed image has a resolution between 300 and 1200 dpi (360 dpi, col. 2, lines 30-36).

Regarding claims 40-42: Claims 40-42 are the method claims corresponding to the apparatus claims 34-36 (respectively). The methods are included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claims 34-36 above.

Regarding claims 45-47, please see rejection rationale/basis as described in claims 34-36 above.

Regarding claims 51-53, please see rejection rationale/basis as described in claims 34-36 above.

Regarding claims 57-59: Claims 57-59 are the method claims corresponding to the apparatus claims 34-36 (respectively). The methods are included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claims 34-36 above.

Regarding claims 63-65: Claims 63-65 corresponds to claims 34-36 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (floppy disk, Zip drives, Spurgeon, par. 13, page 2) for storing computer programs, hence claims 63-65 would be rejected using the same rationale as in claims 34-36.

5. Claims 66-70 rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon as described in claims 31, 37, 43, 48, 54, and/or 60 above, and in view of Ben-Matitayhu et al (U.S. 5795395).

Regarding claims 66-70, Spurgeon discloses all the limitations as cited in claims 31, 37, 43, 48, and 54, but fails to explicitly disclose a subsystem for holding the product transiently in position for printing.

Ben-Matitayhu, in the same field of endeavor for edible food printing system, teaches subsystem for holding (holding mechanism 22 for holding the cake, fig. 1) the product transiently in position for printing.

Art Unit: 2624

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Spurgeon as per teachings of Ben-Matitayhu because of a following reason: (●) to hold the food product in place to avoid tip and/or fall over while the printing is in progress.

Therefore, it would have been obvious to combine Spurgeon with Ben-Matitayhu to obtain the invention as specified in claims 66-70.

### ***Response to Arguments***

Applicant's arguments filed 8/27/04 have been fully considered but they are not persuasive.

(●) Regarding independent claims 31, 37, 43, 48, 54, the applicants argued the cited prior art (U.S. 2002/0008751 to Spurgeon) does not teach an edible printer for printing image data directly on a food product.

In response: Spurgeon explicitly discloses a printer 40 of fig. 1 for printing the image using edible inks onto an edible food items (par. 44). In addition, the applicants argued the prior art of “edible media” is different from applicant’s “food product”. The examiner interprets “edible media” as equivalent to “food product” since both are edible. An example of edible product (i.e. rice paper) can be found in pars. 65-69, pages 4-5.

(●) Regarding newly added claims 66-70, the applicants argued the cited prior art does not teach a subsystem for holding the food product transiently in position for printing. Such limitations are new matters/issues. Please see claims 66-70 rejection rationale/basis for more details.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 2624

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER